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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/972,124	10/05/2001	Russell D. Birkholz	56764US002	3669

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Office of Intellectual Property Counsel
3M Innovative Properties Company
PO Box 33427
St. Paul, MN 55133-3427

EXAMINER

ZIRKER, DANIEL R

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 11/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-21 is/are pending in the application.
- Of the above claim(s) 19, 20 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-18, 21 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

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1. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-18 and 21, drawn to an adhesive article and accompanying label, classified in Class 428, subclass 354.

II. Claims 19 and 20, drawn to a water contact indicating system, classified in Class 428, subclass 343.

2. The inventions are distinct, each from the other because of the following reasons:

3. Inventions Group I and Group II are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as an adhesive tape and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicants traverse on the ground that the species are not patentably distinct, applicants should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or

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admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classifications, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Colene Blank on November 12, 2002 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-18 and 21. Affirmation of this election must be made by applicants in replying to this Office action. Claims 19 and 20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

7. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicants regard as their invention.

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8. Claims 1-18 and 21 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. More particularly, independent claims 1 and 21 appear to define a laminated genus of articles, but are unduly vague and indefinite with respect to the various layered relationships which can exist. For example, in each of the independent claims the "adhesive layer" which ends the claim has no structural relationship with the remainder of the claim and is believed to be desirably present on an outside, i.e., the "third" layer of the particular article. Also the phrases "second layer being in contact" and "the third layer being associated with" are believed to be unduly vague and indefinite with respect to the relationships that can exist. In claims 7 and 8 the word "exposing" is unclear with respect to the structural relationships that can exist, as "is associated with" in claim 9. In claim 14 applicants might desirably wish to include that the first layer "further" can comprise an adhesive, and in claim 15 that the first layer can "further" comprise a release coating.

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

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10. (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-6, 9, 11-13, 16, 18 and 21 are rejected under 35 U.S.C. § 102(b) as being anticipated by Japanese Unexamined Patent Publication H10-90244 as set forth in the two translations provided by applicants to the Examiner, with the non-machine translation being particularly relied upon as supplemented with Figures 1-3 that are set forth in the machine translation. Note particularly the "Object" paragraph, "Means of Solution" paragraph, claim 2, and paragraphs 8, 10-12, 14, 15, 17 and the Examples. As seen particularly in Figure 3, the water detection label can comprise an outer transparent waterproof label 3, adjacent a coloring layer 2 which can be a water soluble dye, which layer is adjacent a water permeable film 1 that can comprise either paper or a non-woven fabric. On the opposing outer surface of layer 3 can be found adhesive layer 4 covered by release paper 5, which is substantially all that the great majority of applicants' claims require.

12. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 7, 8, 10, 14, 15 and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over JP Unexamined Publication H10-90244, as set forth above, and for claims 7 and 8 in further view of EP 1001264A1. H-244 is again relied upon as set forth above, with such parameters as the specific location of the "ink" layer and the "fluid transport substrate" being well within the ordinary skill of the art, as is the presence of a laminating adhesive adhering the first layer to the remainder of the article (claim 14) and the presence of a release coating (claim 15). With respect to the presence of a "hole" in the adhesive article, the Examiner believes that such a structure is both well known in the art, and, alternatively is clearly shown by EP -264. Note the Figures of EP -264, together with the Abstract as clearly teaching the desirability of certain moisture indicating layers containing a hole in their surfaces. The references are clearly combinable, each being taken from the same art, and one of ordinary skill, motivated by an expectation of improved performance properties from the resultant genus of articles would have no trouble in incorporating the hole structure of EP -264 into the structures set forth in the primary reference. Other parameters that are not either expressly or

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inherently disclosed are each believed to be obvious modifications to one of ordinary skill, in the absence of unexpected results .

14. Claims 1-6, 9, 11, 13, 14, 18 and 21 are rejected under 35 U.S.C. § 102(b) as being anticipated by Japanese Patent H8-254953 and its accompanying Japanese Patent Abstract. The Examiner has obtained both a copy of the Japanese patent Abstract of JP -953 as well as a second informal computer translation and the document as found in Japanese, both of which are also being supplied to applicants. Note particularly the Figure in the Japanese patent Abstract, in which a submersion check label 20 which is comprised of a base material 21 that can be a white wood free paper and is water absorbent has on part of its upper surface striped marks formed by printing a water soluble ink thereon, and a transparent protective film 23 that can be polyester adhered over the entire part of the outer surface of the aforementioned base layer 21 so as to cover the ink marks. On the rear surface of layer 21 is found a suitable adhesive coating. Note that although the Examiner has essentially relied on the Japanese patent Abstract, that in the detailed report translation, such information (except for an express teaching of the presence of the adhesive coating on the base material 21 outer surface) can be found in the detailed report at the Object

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section, Construction section, claim 3, and paragraphs 2, 5, 6, 12, 17 and 18.

15. Claims 7, 8, 10, 12 and 15-17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over JP -953 as set forth above in both the translation and the accompanying Japanese patent Abstracts, each taken individually or for claims 7 and 8 in further view of EP -264. The references are again relied upon substantially as set forth above, and with respect to the dependent claims, such parameters as previously discussed above, together with the presence of a release coating (claim 15) and a release liner (claim 16) are each well known in the adhesive coated article art. Additionally, EP -264 is again relied upon as set forth above for disclosing the presence of a hole in the moisture indicating adhesive article, and what parameters that are not either expressly or inherently disclosed are each believed to be obvious modifications for one of ordinary skill, in the absence of unexpected results .

16. The prior art made of record and not relied upon is considered pertinent to applicants' disclosure. Note also Ulrich, the pioneering patent in the field of pressure sensitive acrylate based adhesives.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (703) 308-0031. The examiner

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can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Dzirker:cdc

November 14, 2002

**DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1900-
1700**

Daniel Zirker